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IN THE

Supreme Court of the United States

THE NEW YORK TIMES COMPANY, INC.; NEWSDAY, INC.; THE TIME INCORPORATED MAGAZINE COMPANY; LEXIS/NEXIS and UNIVERSITY MICROFILMS INTERNATIONAL,

Petitioners,

v.

JONATHAN TASINI; MARY KAY BLAKELY; BARBARA GARSON; MARGOT MIFFLIN; SONIA JAFFE ROBBINS and DAVID S. WHITFORD,

Respondents.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SECOND CIRCUIT

PETITION FOR A WRIT OF CERTIORARI

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QUESTION PRESENTED

The Copyright Act expressly grants periodical publishers the right to reproduce and distribute their publications, including articles contributed and separately copyrighted by freelance authors, in, *inter alia*, "any revision" of the publication. 17 U.S.C. § 201(c). For decades, publishers have relied on that provision to make complete editions of their periodicals available in both paper copies and copies stored electronically (such as in the NEXIS database and on CD-ROMs). The Second Circuit nonetheless held in this case that such electronic publication infringes upon the copyrights of freelance authors, a ruling that will require both the massive deletion of freelance articles published in certain electronic copies and the wholesale destruction of other electronic editions of many of the nation's leading periodicals.

The question presented is whether a publisher's reproduction and distribution of its entire periodical not only in print, but also electronically, is privileged under the Copyright Act or instead infringes upon the copyrights held by contributing freelance authors.

STATEMENT PURSUANT TO RULE 29.6

Petitioner The New York Times Company states that it has no corporate parents, and that no publicly held company owns 10% or more of The New York Times Company's stock.

Petitioner Newsday Inc. states that The Tribune Company is its corporate parent, and that no other publicly held company owns 10% or more of Newsday, Inc.'s stock.

Petitioner Time Inc. states that Time Warner Inc. is its corporate parent, and that Time Inc. has no publicly-traded stock.

Petitioner University Microfilms Inc. states that Bell & Howell Co. is its corporate parent, and that no other publicly held company owns 10% or more of University Microfilms, Inc.'s stock.

Petitioner LEXIS/NEXIS (formerly known as Mead Data Central) states that LEXIS/NEXIS is a division of Reed Elsevier Inc., whose corporate parents are Reed International P.L.C. and Elsevier N.V., and that LEXIS/NEXIS has no publicly-traded stock.

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PETITION FOR A WRIT OF CERTIORARI

Petitioners respectfully petition for a writ of certiorari to review the judgment of the United States Court of Appeals for the Second Circuit in this case.

OPINIONS BELOW

The district court's opinion (per Sotomayor, D.J. (now circuit judge)) granting petitioners' summary judgment motion (Appendix ("Pet. App.") 23a-80a) is published at 972 F. Supp. 804. The district court's subsequent opinion reaffirming that holding and denying respondents' motion for reconsideration (Pet. App. 83a-105a) is published at 981 F. Supp. 841. The court of appeals' opinion (per Winter, C.J., joined by Miner and Pooler, JJ.) reversing (Pet. App. 1a-22a) is published at 206 F.3d 161. The court of appeals' orders denying rehearing and rehearing en banc (*id.* 106a-107a), staying the mandate (*id.* 108a-110a), and extending the stay of the mandate (*id.* 111a-113a) are not otherwise published.

STATEMENT OF JURISDICTION

The court of appeals entered its opinion and order on September 24, 1999, and denied rehearing and rehearing en banc on April 6, 2000. Justice Ginsburg subsequently extended the time to file this petition for a writ of certiorari to and including August 4, 2000. Petitioners invoke this Court's jurisdiction under 28 U.S.C. § 1254(1).

STATUTORY PROVISIONS INVOLVED

The provisions of the Copyright Act of 1976, 17 U.S.C. § 101, *et seq.*, relevant to this petition are reprinted in the Appendix at 114a-125a.

STATEMENT OF THE CASE

Petitioners publish a number of periodicals in both print and electronic copies. Some include articles contributed by respondents, who are freelance authors that own the copyrights to their individual contributions. The district court held that the electronic copies were privileged under Section 201(c) of the Copyright Act, which, in the absence of an express agreement,

permits a publisher to include individually copyrighted articles contributed by freelancers in copies of a periodical and "any revision" of that periodical. 17 U.S.C. § 201(c). The Second Circuit reversed, holding that publication in electronic copies infringes the copyrights held by freelance authors.

The court of appeals' holding merits this Court's immediate review because it will require publishers and electronic database companies, nationwide, irreversibly to delete tens of thousands of freelance contributions currently stored in electronic archives. It also will force the wholesale destruction of CD-ROMs containing periodicals that include only a handful of such contributions. In addition, the decision below conflicts with decisions of this Court and of other circuits holding that the conduct of third parties is irrelevant to a claim of direct copyright infringement and that "originality" is the sine qua non of a "new" work.

1. Petitioners publish a number of the nation's most prominent newspapers and special interest magazines, including *The New York Times* ("the *Times*"), *Newsday*, and *Sports Illustrated* (collectively, "the Publications"), in both print and electronic copies. The electronic copies appear in databases such as NEXIS, which contains essentially the complete editorial content of the Publications dating from the early 1980s, as well as CD-ROM products, which contain the same content of the *Times*, as well as complete photographic copies of *The New York Times Sunday Magazine* and *The New York Times Book Review*. It is undisputed that, in every instance, the electronic copies are created from complete editions of the periodicals, not on an article-by-article basis.

These electronic copies have revolutionized research in ways directly anticipated by Congress as far back as the early 1960s. They function as the modern equivalent of national library shelves, combined with computerized search tools that serve as indices with awesome power. This makes it possible to complete in seconds research that previously would have required months. For example, prior to the "information age," a

researcher would locate articles in back issues of the *Times* by retrieving and studying a hard-copy index of each year to be researched, then retrieving each individual article from either hard copies or microfilm reproductions of the newspaper. Now, the identical research can be completed instantly and remotely by entering a command into the search engine associated with a database; indeed, the electronic search generally produces far more accurate results because it retrieves articles based on their text rather than on the general subject headings set forth in the hard copy indices.

2. Respondents are a number of freelance authors, led by the president of an organization (the National Writers Union) dedicated to advancing the interests of freelance authors. Between 1990 and 1993, respondents contributed articles, in which they retained separate copyrights,[1] to petitioners' publications (collectively, "the Articles"). It is undisputed that respondents provided the Articles to petitioners precisely for the purpose of having them included in petitioners' Publications and that no agreement between petitioners and respondents limits distribution of the Articles to print editions only.

Nonetheless, respondents contend that electronic publication of entire periodical issues that contain their articles constitutes direct copyright infringement. Specifically, they maintain that the Copyright Act, as a matter of law, limits publishers to reproducing and distributing the full contents of their periodicals only in paper copies absent separate contractual agreements with the freelance contributors. (Plaintiffs' Amended Compl. ¶ 1). Of particular note, respondents do *not* assert that petitioners contribute in any way to copyright infringement by third parties who retrieve articles from the databases, a claim that automatically would be defeated under this Court's decision in *Sony Corporation of America v. Universal City Studios*, 464

1. Respondents' contributions thus differ from articles written by the Publications' employees, which the Copyright Act deems "works for hire" and for which the Publications hold the copyright. 17 U.S.C. § 101 (defining "works made for hire").

U.S. 417 (1984), because the databases indisputably have "substantial noninfringing uses." Pet. App. 33a n.3; *see also* Tr. Oct. 17, 1996 at 78 (representation of respondents' counsel: "We have not claimed that any end users have engaged in acts of direct infringement, and we have not in fact claimed that either the publisher defendants or the database defendants are guilty of contributory or vicarious liability with respect to direct infringement committed by end users.").

3. The district court rejected respondents' claim, holding that petitioners' publishing activities are contemplated and privileged by Section 201(c) of the Copyright Act. Pet. App. 23a-80a. The Act defines the Publications as "collective works" (a type of "compilation") and the Articles as "contributions" to those collective works. 17 U.S.C. § 101. Section 201(c) grants a publisher, absent an agreement to the contrary, "the privilege of reproducing and distributing the contribution as part of that particular collective work, any revision of that collective work, and any later collective work in the same series." *Id.* at § 201(c). The district court held that, because a print edition of a periodical is a "collective work," the electronic copy of the same periodical, whether distributed alone or stored in a larger database comprised of a number of such editions and other works, falls within the phrase "any revision of that collective work."

The district court explained that respondents were wrong to assert that electronic publication results in a work fundamentally different from the print edition. The databases indisputably "permit users to consult defendants' periodicals in new ways and with new efficiency, but for the *same purposes* that they might otherwise review the hard copy versions of those periodicals." Pet. App. 75a (emphasis added). Although some (but not all) of the electronic copies differ slightly in appearance from the original print editions — because in the ASCII text copies no graphics, agate-type and paper page layouts are present — that is precisely what makes them "revisions" rather than originals. Pet. App. 72a-73a. In particular, the failure to retain

the exact arrangement of a particular periodical is "of only peripheral concern" when petitioners retain their single most important original contribution: the selection of the individual articles to be published. *Id.* The commitment of the *Times* editorial staff to "[i]dentifying 'all the news that's fit to print,' " for example, is "a highly subjective undertaking, one that different editors and different periodicals undoubtedly perform with varying degrees of success." *Id.* 69a. That "selection," in turn, "remains evident online" because petitioners uniformly include, with each article in the databases, information identifying the publication, edition, and even pagination of the hard copy edition in which that article was originally published. *Id.* 71a.

Moreover, as the district court also noted, the basic, definitional concepts of the Copyright Act expressly state that "revisions," including the "any revision" incorporated into Section 201(c), can embrace substantial changes from the original edition of a publication. The Act provides that "editorial revisions" to a preexisting work can be so substantial that they create a *new work* with its own copyright protections. 17 U.S.C. § 101 (providing that "editorial revisions" can create new "derivative work"). As the district court succinctly explained, "If 'editorial revisions' can transform a work to this extent, the broader 'any revisions' language of Section 201(c) suggests the promise of even greater change." Pet. App. 58a.

Fundamental to the district court's conclusion was its recognition that Congress intentionally drafted the terms of the Copyright Act to be "media neutral." *Id.* 57a. Section 101 of the Act states that a "literary work," such as a periodical, remains the same "regardless of" how it is embodied, whether in paper or instead on "tapes, disks, or cards." 17 U.S.C. § 101; *see also id.* (a "copy" of a work is the same whatever the medium — whether "now known or later developed" — in which it is embodied). These provisions are set forth in the very first section of the Act, because Congress intentionally sought "to accommodate developing technologies," Pet. App. 57a,

specifically employing broad terms so " 'that they can be adapted as time goes by to each of new advancing media.' " *Id.* (*quoting* Copyright Law Revision: Hearing on H.R. 4347, 4680, 6831, 6835 Before Subcomm. No. 3 of the House Comm. on the Judiciary, 89th Cong., 1st Sess. 57 (1965) (testimony of George D. Cary, Deputy Register of Copyrights)).

The district court also recognized that Congress enacted Section 201(c) principally to overturn those decisions under the predecessor Copyright Act of 1909 holding that publishers could exploit freelance authors' contributions *apart* from the rest of the collective work. Pet. App. 60a. Electronic copies do not implicate that concern because regardless of how such copies may be accessed and read, the entire editorial content of the collective work is published *together*. Thus, as the district court concluded, Congress intended Section 201(c) to "avoid the exploitation of individual articles," without "prevent[ing] publishers from reworking their collective works in significant ways." *Id.* 72a.[2]

Finally, the district court rejected respondents' claim that copies published electronically result in a "new" collective work rather than in a permissible "revision" under Section 201(c). Under this Court's decision in *Feist Publications v. Rural Telephone Service Co.*, 499 U.S. 340, 359-61 (1991), a "new" work is created only if it fails to retain the "original" elements — whether "selection, coordination, or arrangement" — of the prior work. 499 U.S. 340, 359-61 (1991). When the original element of a periodical (the "compilation" copyright contemplated by Section 101) is retained in the electronic copy

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2. The district court further noted that authors' representatives had in fact made clear in the debates over the 1976 Copyright Act that they " 'obviously' " did not object to the provisions insofar as such "revisions" included selecting " 'contributions, or their order, or including different contributions.' " Pet. App. 60a (*citing and quoting* 1964 Revision Bill With Discussions And Comments, Copyright Law Revision, Part 5, at 9 (H. Comm. Print 1965) (statement of Author's Representative, Harriet Pilpel)).

— here, the original selection of articles — "then the electronic reproductions can be deemed permissible revisions of the publisher defendants' collective works." Pet. App. 66a. The district court accordingly entered summary judgment for petitioners.

4. On respondents' appeal, the Second Circuit reversed in an opinion remarkable for its fundamental inconsistency with governing precedent of this Court and decisions of other circuits, for its inclusion of only one citation to a copyright law decision,[3] and for the fact that it summarily and retroactively invalidates a long-settled publishing practice. The Second Circuit held that, as a matter of law, "Section 201(c) does not permit the Publishers to license individually copyrighted works for inclusion in the electronic databases." Pet. App. 7a. Instead, the "any revision" language of Section 201(c), according to the Second Circuit, "protects only later editions of a particular issue of a periodical, such as the final edition of a newspaper." *Id.* 10a.

The legal principle established by the Second Circuit is that a publisher may be guilty of direct copyright infringement simply by publishing electronic copies of periodicals that permit third parties to retrieve individual articles from the electronic databases. As the court of appeals explained:

> Subscribers to NEXIS are able to access an almost infinite combination of articles from one or more publishers by using the database's advanced search engine. The articles may be retrieved individually or, for example, together with others on like topics. Such retrieval makes the article available without any material from the rest of the periodical in which it first appeared.

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3. The one instance is itself meager: a "see also" citation to *Feist* as "discussing factual compilations." Pet. App. 15 a. The only other mention of copyright law decisions comes in a portion of the opinion dealing with "licensing," which is not at issue in this petition. *Id.* 19a-20a.

Pet. App. 4a. Similarly, the CD-ROM products "contain[] many articles that may be retrieved [through a search engine] according to criteria unrelated to the particular edition in which the articles first appeared." *Id.* 16a.[4]

The court of appeals believed that the ability of end users to retrieve articles individually could not be reconciled with the Copyright Act in two respects. First, the Second Circuit maintained that such individually accessible electronic copies fail to retain the original "selection" of the print edition because "the Authors' works are now available to the public on one or more electronic databases and may be retrieved individually or in combination with other pieces originally published in different editions of the periodical or in different periodicals." Pet. App. 6a-7a. It concluded that such a process resulted in "at best a new anthology of innumerable editions of the *Times*, and at worst a new anthology of innumerable articles from these editions," not "a 'revision' of any (or all) particular editions." *Id.* 17a.

Second, the court of appeals opined that the availability of individually accessible electronic copies infringes upon authors' rights to exploit their individual contributions:

> Section 201(c) would not permit a Publisher to sell a hard copy of an Author's article directly to the public even if the Publisher also offered for individual sale all of the other articles from the particular edition. We see nothing in the revision provision that would allow the Publishers to achieve the same goal indirectly through NEXIS.

Id. 13a.

5. On April 26, 2000, the Second Circuit granted a stay of its mandate upon a showing by petitioners that a certiorari petition would present a substantial question meriting this

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4. *See also id.* 14a ("NEXIS is a database comprising thousands or millions of individually retrievable articles taken from hundreds or thousands of periodicals.").

Court's review and that there existed good grounds for a stay. *See* Pet. App. 108a-110a; FRAP 41. In particular, petitioners established, through undisputed sworn affidavits, that the judgment in this case would require petitioners to delete vast numbers of freelance articles permanently from the NEXIS database and to destroy large numbers of CD-ROMs, causing irreparable injury both to petitioners and to the public. *See infra* at 14-16 & nn.7-8.

6. This petition for a writ of certiorari followed.

REASONS FOR GRANTING THE WRIT

The petition should be granted for two reasons. *First*, the Second Circuit's judgment, as a practical matter, sets a national rule requiring the destruction of decades' worth of articles currently stored in electronic archives. Consistent with this Court's practice of immediately reviewing decisions under the Copyright Act that overturn settled practices in publishing — an inherently national industry closely tied to the constitutional values underlying the First Amendment — review should be granted to prevent this irreversible, nationwide harm.

Second, the Second Circuit's decision conflicts with holdings of this Court and of other circuits in two important ways. It espouses the legal principle that a publisher may be held liable for direct copyright infringement because of the conduct of the third parties who retrieve articles from the databases. That holding is contrary to this Court's decision in *Sony* and *Sony*'s progeny in other circuits, which hold that third-party conduct is irrelevant to a direct infringement claim. The Second Circuit's judgment also holds that electronic publication results in a "new" work. That holding is contrary to this Court's decision in *Feist* that the "mechanical" reproduction of a work (as opposed to one adding some element of "originality") cannot create a new, copyrightable work, as well as *Feist*'s progeny in other circuits. In both respects, the Second Circuit's decision also conflicts with this Court's holding that, in cases of doubt, the Copyright Act should be construed to encourage the development of new technologies.

I. The Decision Below Sets A National Rule Meriting This Court's Immediate Intervention Because It Will Cause Irreparable Harm To Electronic Archives Nationwide.

One consistent theme emerges from this Court's leading copyright decisions: the Court has taken care to review rulings of the courts of appeals that disrupt settled practices in the publishing and related industries, even absent a direct circuit conflict.[5] The Court's prompt intervention in such cases is sound: the publishing industry is virtually unique in that a decision of a single circuit (particularly the Second Circuit, because so many publishers are located in New York City) can effectively require a publisher to alter its practices fundamentally throughout the nation. Moreover, the fate of publishing (and the related music and entertainment industries) is directly bound up with the values underlying the First Amendment. " 'The fortunes of the law of copyright have always been closely connected with freedom of expression, on the one hand, and with technological improvements in means of dissemination, on the other.' " *Sony Corp. of Am. v. Universal City Studios*, 464 U.S. 417, 431 n.12 (1984) (*quoting* B. Kaplan, An Unhurried View of Copyright vii-viii (1967)).

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5. *See Campbell v. Acuff-Rose Music*, 510 U.S. 569 (1994) (holding that musical parody constitutes "fair use"; petitioner alleged only a conflict in principle over treatment of musical parodies); *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340 (1991) (holding that telephone white pages are not copyrightable if they lack original "selection, coordination, or arrangement"; petitioner alleged only a conflict in principle over "sweat of the brow doctrine"); *Harper & Row v. Nation Enters.*, 471 U.S. 539 (1985) (holding that use of quotations from unpublished memoirs is not protected "fair use"; petitioner alleged only a conflict in principle over fair use doctrine); *Mills Music v. Snyder*, 469 U.S. 153 (1984) (holding that publisher was entitled to share in royalties from derivative works under terms of grant from author; petitioner alleged no conflict at all); *Sony Corp. v. Universal City Studios*, 464 U.S. 417 (1984) (holding that video tape recorder manufacturers are not liable for contributory infringement based on taping by users of the recorders; petitioner alleged only a conflict in principle with a decision of Court of Claims).

The Court's concerns have been greatly amplified with the advent of electronic publishing. A single court of appeals' decision holding that a database such as NEXIS may not lawfully include various materials immediately denies access to those materials to individuals nationwide and, indeed, worldwide. In this case, for example, it makes no difference what any other regional court of appeals may hold with respect to the Section 201(c) privilege: the Second Circuit's holding effectively governs the NEXIS databases without regard to the geographic location of the individuals who access those databases or the identity or location of the freelancers whose works have been included with the rest of the periodical. For example, the Second Circuit's decision conflicts directly with a ruling by the Southern District of Florida, which expressly adopted the holding and rationale of the district court in this case. *Greenberg v. National Geographic Soc'y*, No. 97-3924-civ, 1998 U.S. Dist. LEXIS 18060 (S.D. Fla. May 14, 1998). The district court in *Greenberg* rejected a challenge brought by freelance photographers to the National Geographic Society's practice of distributing a complete collection of back issues of *National Geographic* magazine on CD-ROM. Although the Section 201(c) privilege in theory still protects such electronic publication in the Southern District of Florida (in fact, only the Second Circuit has held to the contrary), in reality, publishers and database providers must abide by the Second Circuit's judgment no matter whether the Eleventh Circuit subsequently affirms or reverses the district court's decision in *Greenberg*.[6]

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6. Another decision involving Section 201(c), *Ryan v. Carl Corp.*, 23 F. Supp. 2d 1146 (N.D. Cal. 1998), addressed the sale of individual articles to which the Section 201(c) privilege was held not to apply. The district court's decision in *Ryan*, which cites the district court's opinion in this case favorably, refutes the Second Circuit's professed concern that petitioners' interpretation of Section 201(c) would eviscerate the freelancers' copyrights in their individual works. Pet. App. 12a-13a. The *Ryan* decision underscores that the interpretation of Section 201(c) relied on by petitioners leaves undisturbed

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There are two other respects in which the Second Circuit's decision effectively sets an immediate national rule not subject to further percolation in the courts of appeals. *First*, it applies well beyond the individual parties to this case. The corporate owner of NEXIS is a party defendant subject to the Second Circuit's judgment. The NEXIS database contains editions of hundreds of other publications extending as far back as the 1970s. In order to avoid infringement liability with respect to those publications, NEXIS, in conjunction with its publisher-licensors, must locate and delete the freelance articles in all those publications even though those other publishers are not parties to this case and have their publishing facilities in locations throughout the country outside the three states that comprise the Second Circuit. University Microfilms, by far the nation's largest producer of informational CD-ROM products, is a party defendant in this case and similarly must comply with the judgment with respect not only to the three publishers who are defendants but to *all* of the publications contained in its products. Furthermore, the expansive jurisdictional provision of the Copyright Act means that the nation's other major electronic databases and producers of CD-ROMs, including WESTLAW, Dow Jones Interactive and Dialog, cannot ignore the Second Circuit's ruling in this case. *See* 28 U.S.C. § 1400(a) (copyright infringement suit may be brought in any district where the defendant may be found).

Thus, it is hard to identify a substantial periodical publisher or electronic database company that is not required to delete a significant body of information to avoid serious risk of infringement liability under the Second Circuit's judgment. In the time since the Second Circuit issued its opinion in this case, the National Writers Union, led by respondent Tasini, has

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respondents' ability to exploit their Articles on an individual basis and is entirely consistent with the congressional intent to draw a clear dividing line between aggregate uses (held by the Publishers) and individual uses (held by freelancers) of the copyrighted articles contained in collective works. *See supra* at 6.

threatened publishers and database companies *nationwide* with infringement suits, unless they comply with the Second Circuit's judgment. See http://www.nwu.org/prc/prchome.htm (visited Aug. 2, 2000). In fact, just three weeks ago, Mr. Tasini and the NWU openly threatened to sue San Jose, California-based Knight Ridder, Inc. over its online library. Randy Dotinga, *Free-Lance Union Demands Restitution from Papers: Writers Union Targets Knight Ridder-Owned News Library*, (last modified July 13, 2000) <http://www. editorandpublisher.com/ephome/news/newshtm/stories/071300nl.htm>.

Second, the effects of the Second Circuit's judgment are irreversible. The process of locating the vast number of freelance articles contained in the NEXIS database has already begun; some 100,000 articles may have to be permanently deleted at an enormous cost and investment of time. With respect to already published CD-ROM copies of periodicals, the immediate impact of the decision below is even more serious. Because individual articles cannot be deleted from a CD-ROM, the entire CD-ROM must be removed from the marketplace, even though most of the articles contained in the periodicals carried on those discs were not written by freelance authors.

The gravity of these deletions is hard to overstate. Precisely because the publication of periodicals in electronic copies has been an accepted publishing practice for decades, the archives of the nations' periodicals are now (and increasingly will be) stored, in very large part, electronically. Relying on a decades-old and industry-wide understanding of Section 201(c) of the Act, many institutions, including the Library of Congress, have replaced their crumbling collections of paper periodicals with non-print copies in an effort to maintain the integrity of the nation's historical records. *See, e.g.*, Claire Anne Fitzgerald, *Freelance Journalism After* Tasini, The Legal Intelligencer, Feb. 3, 2000 (noting that the practical impact of the Second Circuit's decision is "the loss of scholarship particularly where hard copies of * * * works have been discarded in favor of electronic storage"). This case accordingly will determine

whether historians, students, scholars, and others will continue to enjoy ready access to the complete historical record of the nation's periodicals in "any tangible medium of expression," 17 U.S.C. § 102(a), or will instead be forced to revert to the research methods of a prior generation: the *Reader's Guide to Periodical Literature* and bound paper copies — to the extent such copies still exist. *See* Kurt A. Wimmer, *E-Litigation: The Digital Dilemma*, Nat'l L. J., Oct. 25, 1999, at B10 ("[T]he broader impact of *Tasini* will be felt not only by professional researchers, but also by ***millions*** of Internet users who expect to find comprehensive and reliable archives at media-related sites.") (emphasis added).[7]

These effects, disastrous for the nation's libraries, academic institutions, and publishers, are fact, not speculation. After the Second Circuit entered its decision, respondent Tasini declared that " '[e]very single data provider is now at risk * * * . We could go into court tomorrow if we wanted and ask *to shut down every database*.' " Felicity Barringer, *Freelancers Win Appeal In Copyright Suit*, N.Y. Times, Sept. 28, 1999, at C1 (emphasis added). Mr. Tasini was quite emphatic that the judgment portended a " 'tidal wave of lawsuits,' " Jason Williams, *Who Owns History*?, Editor & Publ'r Mag., Dec. 11, 1999, at 26, a metaphor he recently updated by characterizing

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7. Libraries will be hardest hit by the information-destroying effects of the decision below because, as one commentator has recently recognized, it is "unlikely, given the current budget trends, that libraries will be able to consistently purchase both an electronic version and a print or microfilm version of all resources, and libraries may be forced to choose between easy access and complete access." Shelly Warwick, *Changing the* Times: *the* Tasini *Decision and Why Future Full-Test Sources May Cost More or Not be Complete*, in Proceedings of the 21st National Online Meeting 487 (Martha E. Williams ed., 2000). The situation is particularly grave for large research institutions, which will be increasingly dependent on electronic archives in the future. See generally *Commission on Physical Sciences, Mathematics, and Applications, National Research Council, LC21: A Digital Strategy for the Library of Congress* (forthcoming 2000).

virtually every newspaper in the country as sitting on a "financial ticking time bomb." *See* Randy Dotinga, *Free-Lance Union Demands Restitution from Papers: Writers Union Targets Knight Ridder-Owned News Library*, (last modified July 13, 2000) <http://www. editorandpublisher.com/ephome/news/newshtm/stories/071300nl.htm>.

Representatives of publishers and database companies, in turn, submitted sworn and uncontradicted testimony in the Second Circuit that deletions of freelance articles would have to begin immediately and that CD-ROM products would have to be withdrawn from the market.[8] On the basis of this testimony,

8. *See, e.g.*, Declaration of Kenneth A. Tillman, attached to Motion by Defendants-Appellees for Stay of Mandate Pending Filing of Petition for Writ of Certiorari, at ¶ 16 ("UMI would have to consider removing from circulation all CD-ROM discs containing any freelance articles, in addition to those that contain Appellants' articles. It would be impossible, as a practical matter, to locate all such articles, which would include travel pieces, book reviews, stories sent in by stringers, letters to the editor, Op-ed pieces, and unsolicited articles sent in by public officials and other citizens. * * * Because of the logistical impossibility of identifying all such articles and removing the discs containing them, UMI's only recourse might be to remove from circulation all CD-ROMs from past years * * *. This would make the UMI CD-ROM products useless as a historical archive."); Declaration of Fred T. Leftrict, Jr., attached to Motion by Defendants-Appellees for Stay of Mandate Pending Filing of Petition for Writ of Certiorari, at ¶ 7 ("NEXIS could be forced to delete many other freelance articles in addition to Appellants', because it would be impossible, as a practical matter, for publishers whose publications appear on NEXIS to identify, locate, and negotiate with all freelance writers whose works they have published since NEXIS began storing their periodicals. The number of works lost to NEXIS and the public through their process could number in the tens or hundreds of thousands."); Declaration of Alan Greengrass, attached to Motion by Defendants-Appellees for Stay of Mandate Pending Filing of Petition for Writ of Certiorari, at ¶ 12 ("the *Times* would have to consider deleting from the electronic databases many other freelance articles in addition to Appellants' * * * . The number of works lost through this process could number in the thousands or tens of thousands"). These Declarations are included in the lodging to be filed with petitioner's reply.

the court of appeals stayed its mandate pending the disposition of this petition for certiorari. The Second Circuit therefore was manifestly wrong to offer that publishers and freelance authors may "contract around" its holding by entering into agreements permitting electronic publication of freelance contributions. Pet. App. 17a. That suggestion fails to grasp the practical impossibility of locating and negotiating with thousands of individual freelance authors, their transferees and/or their heirs or statutory successors, *see* 17 U.S.C. § 203, in the face of threats of litigation regarding the use of articles *already stored* in electronic archives and regarding the damages due as a result of *prior* electronic publication. Indeed, the sheer logistical difficulties inherent in this process will lead to the deletion of freelance contributions even in the absence of specific demands to do so from freelancers. *See* Nancy Garman, *The* Tasini *Decision and Database Integrity*, Online, Jan. 1, 2000, at 8 ("[W]hat about the ***millions*** of articles online in full text that date back to the 1970s and 1980s, and are not covered by explicit author agreements? . . . [C]omprehensive searches of full-text files will be a thing of the past, since you can't search what isn't there.") (emphasis added).

Moreover, the organization led by respondent Tasini (the National Writers Union) has rejected the contractual solution in favor of class action litigation. In response to the Second Circuit's decision in this case, *The Boston Globe*, which is a subsidiary of petitioner The New York Times Company, adopted a policy of hiring freelance authors only upon concluding contractual agreements granting it the right to publish freelance contributions electronically. The National Writers Union has filed a class action on behalf of approximately nine hundred freelance authors alleging that the policy constitutes an invalid business practice under Massachusetts state law. *See Marx v. The Globe Newspaper Co.*, Mass. Super. Ct. No. 00-2579 (complaint filed June 12, 2000).

In sum, not since the Ninth Circuit's decision that this Court reversed in *Sony Corporation of America v. Universal Studios*, 464 U.S. 417 (1984), which involved a challenge to the public's right to videotape television programs at home, has there been a copyright decision that so precipitately makes unlawful so firmly established and widespread a practice or one that so adversely affects the consumer, commercial, library, and academic communities. *See also id.* at 456 ("One may search the Copyright Act in vain for any sign that the elected representatives of the millions of people who watch television every day have made it unlawful to copy a program for later viewing at home * * * ."). The Second Circuit's decision, in and of itself and entirely apart from what any other circuit might later hold, forces the destruction of large volumes of constitutionally protected material without any proper basis. Unlike the myriad cases — by far the most typical on the certiorari docket — in which the adverse consequences of an erroneous ruling by a single circuit court are largely reversible by later review in this Court after further percolation in the lower courts, this is a case in which the necessarily risk-averse position of petitioners, as well as other publishers and database providers around the country, leaves no choice other than to take irreversible, information-destroying steps when the Second Circuit's judgment takes effect. In cases such as this, where any possibility of subsequent error correction necessarily would come too late, this Court need only decide one question in determining whether to grant certiorari: Is the decision below sufficiently dubious on the merits such that the massive destruction of constitutionally protected information is too great a cost to bear to warrant deferring review of the question presented? *Cf. Nebraska Press Assn. v. Stuart*, 427 U.S. 539, 580 (1976) (Brennan, J., concurring in the judgment) (reiterating view that "each passing day constituted an irreparable infringement on First Amendment values"). Here, for the reasons set forth below, it is difficult to conceive of a copyright decision that could rest on more fundamental misapplications of settled

copyright law, or that could have greater adverse consequences for the public's right of access to copyrighted expression.

Fortunately, the necessity of immediate review is matched by the unique suitability of this case as a vehicle for addressing the question presented. The parties, which include multiple freelance authors and several publications and database providers, compiled an exhaustive record regarding the nature of the Publications, the electronic copies stored in databases, and the Articles in question. *Cf. Avis Rent A Car System v. Aguilar*, 120 S. Ct. 2029, 2033 (2000) (Thomas, J., dissenting from denial of certiorari) (noting that members of the Court may have been disinclined to grant certiorari based on the lack of a developed factual record). (Petitioners have submitted to this Court a copy of the record on the joint motions for summary judgment, which amply demonstrates the factual development below.) By contrast, any later case (such as a subsequent copyright infringement suit brought by a freelance author) is very unlikely to have the benefit of so broad an array of parties or of so fully developed a record, especially in light of the *de facto* national scope of the Second Circuit's decision. This case accordingly merits the Court's immediate review.

II. Certiorari Is Warranted Because The Decision Below Conflicts With Decisions Of This Court And Of Other Circuits.

The Second Circuit's holding that electronic publication violates the copyrights held by contributing freelance authors conflicts with two important principles of copyright law settled by this Court and other circuits. Both conflicts are inexplicable given that the only difference between the copies stored in the electronic databases and paper editions of periodicals stored on library shelves is that the former accelerate and improve research, benefits that are entirely consonant with the goals of the Copyright Act. As the district court recognized, electronic databases "permit users to consult defendants' periodicals in new ways and with new efficiency, but for the same purposes that they might otherwise review the hard copy versions of those

periodicals." Pet. App. 75a. There can be no dispute that research in back copies of periodicals, even in paper copies, consistently involves searching for individual articles rather than complete back editions and that Congress, in enacting the 1976 Copyright Act, was fully cognizant of the impending development of the specific technologies at issue in this case: computers and electronic databases.[9]

Moreover, as the district court also recognized, under the Copyright Act's media neutral definitions, periodicals remain the same works whether published in paper or on a computer disc. Specifically, under Section 101 of the Act, a "literary work" remains the same "regardless of" whether it is embodied in paper or instead on a diskette and a "copy" of a work is the same whatever the medium in which it is embodied. Pet. App. 57a (citing 17 U.S.C. § 101).

The Second Circuit's decision, by contrast, proceeds as though: (i) users of the databases retrieve *individual articles* when they research back issues electronically but *entire editions*

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9. For example, the Copyright Office explained in testimony regarding the Act that

> you can read the Bill from beginning to end and you won't find in it any reference to computers [even though] these are one of the coming instruments of communication in the future. We have tried to phrase the broad rights granted in such a way that they can be adapted as time goes on to each of the new advancing media.

Copyright Law Revision: Hearing on H.R. 4347, 4680, 6831, 6835 Before Subcomm. No. 3 of the House Comm. on the Judiciary, 89th Cong., 1st Sess. 57 (1965) (testimony of George D. Cary, Deputy Register of Copyrights). Congress also was specifically presented with testimony confirming that computer databases would be used as vast libraries in which complete books and periodicals could be stored in their entirety but accessed in exactly the way the NEXIS database and UMI CD-ROMs are used today. Hearings on H.R. 2223 at 338 (testimony of Paul G. Zurkowski, President, Information Industry Association) (under the Act, collective works such as encyclopedias and periodicals would be input, and through computer equivalents of the *Reader's Guide*, located to access individual contributions).

when they use paper indices and paper or microfilm editions of the periodicals; and (ii) Congress intended to treat electronic databases and print editions as somehow fundamentally different under the Copyright Act. In fact, nobody can seriously maintain either of these notions. Under the Second Circuit's artificial approach to paper versus electronic copies and new versus revised works, new and infringing "anthologies" are created on the hard drive of every computer in a judge's chambers whenever multiple programs (word processing or spreadsheet), memos from law clerks, letters, or other copyrightable materials are stored. That unworkable proposition is completely inconsistent with Congressional intent and the widely held recognition that it makes no sense to impose print-related concepts on the bits and bytes that make up databases. *See* Jane Ginsburg, *"No 'Sweat'? Copyright and Other Protection of Works of Information After* Feist v. Rural Telephone," 92 Colum. L. Rev. 338, 345 (1992) (computer databases "may lack any 'arrangement,' for they are designed to permit the user to impose her own search criteria on the mass of information").[10] Instead, it is the district court's conclusion — that "NEXIS and UMI's CD-ROMs carry recognizable versions of the publisher-defendants' newspapers and magazines" and simply "store those versions within something akin to an electronic research library," Pet. App. 75a n.16 — that the Copyright Act's policy of media neutrality plainly compels.

The problems created by the decision below are all the more troubling because the Second Circuit has construed the Copyright Act so as to create a conflict between the Act's

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10. *See also* Robert C. Denicola, *Copyright in Collections of Facts: A Theory for the Protection of Nonfiction Literary Works*, 81 Colum. L. Rev. 516, 531 (1981) (it is "senseless to seek . . . a specific, fixed arrangement of data. There is simply a collection of information stored in an electronic memory — information that can be arranged and retrieved in variations limited only by the capabilities of the computer and the sophistication of the retrieval program").

terms and a vital form of technological development. This Court, however, has definitively settled that, in cases of doubt, the Copyright Act should be read to *encourage* new technologies and that restrictions on the use of technology should be left to Congress:

> Sound policy, as well as history, supports our consistent deference to Congress when major technological innovations alter the market for copyrighted materials. Congress has the constitutional authority and the institutional ability to accommodate fully the varied permutations of competing interests that are inevitably implicated by such new technology.[11]

Sony Corp. of Am. v. Universal City Studios, 464 U.S. 417, (1984) (*citing Twentieth Century Music Corp. v. Aiken*, 422 U.S. 151, 156 (1975); *Fox Film Corp. v. Doyal*, 286 U.S. 123, 127 (1932). Other courts of appeals consistently have recognized, and adhered to, this principle of construction.[12] The Second

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11. It therefore bears noting that in 1983, Congress considered, but refused to adopt, NWU-supported legislation that would have allowed freelancers to terminate the automatic transfer of rights in Section 201(c) if, among other things, "changes in . . . media exploitation" had proved "disadvantageous to the author." Hearing on S. 2044 at 45; S. 2138, 98th Cong. 1st Sess.; 129 Cong. Rec. 34,442 (1983). This legislative history briefed for, but ignored by, the Second Circuit, underscores the impropriety of undoing, by judicial fiat, the deliberate congressional balancing of interests reflected in Section 201(c). *See Rosado v. Wyman*, 397 U.S. 397, 415 n.17 (1970) (congressional failure to adopt proposed amendment "gives rise to an inference" of intent not to enact substance of rejected proposal).

12. As then-Judge Posner wrote for the Seventh Circuit: Congress "wanted the courts to interpret the definitional provisions of the new act flexibly, so that it would cover new technologies as they appeared, rather than to interpret those provisions narrowly and so force Congress periodically to update the act." *WGN Continental Broadcasting Co. v. United Video*, 693 F.2d 622 (CA7 1982); *see also Sony Computer*

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Circuit's decision not only rejected this principle but did so in a manner that brought the Copyright Act into direct conflict with the two other, settled principles of copyright law described below, thus triply meriting review and reversal by this Court.

A. The Decision Below Conflicts With The Holding Of This Court And Other Circuits That The Predicted Conduct Of Independent Third Parties Is Irrelevant To A Claim Of Copyright Infringement.

The Second Circuit's opinion acknowledges that this case involves allegations of direct copyright infringement only: "[T]he Authors' claim is that the copyright each owns in his or her individual articles was infringed *when the Publishers provided them to the electronic databases*." Pet. App. 5a (emphasis added). It is undisputed, however, that "when" such delivery was made, it was delivery of the complete editorial contents of each respective periodical, in the same computer-readable format in which those contents are delivered to those

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Entertainment v. Connectix Corp., 203 F.3d 596, 605 (CA9 2000) (refusing to adopt holding that would have effect of requiring difficult and less efficient development of computer software as resulting in " 'wasted effort' " antithetical to copyright law (*quoting Feist*, 499 U.S. at 354)); *Columbia Pictures Indus. v. Redd Horne, Inc.*, 749 F.2d 154, 157 (CA3 1984) ("It is acknowledged that it is the role of the Congress, not the courts, to formulate new principles of copyright law when the legislature has determined that technological innovations have made them necessary.") (*citing Sony v. Universal, supra; Teleprompter Corp. v. CBS*, 415 U.S. 394, 414 (1974)); *Apple Computer v. Franklin Computer Corp.*, 714 F.2d 1240, 1253 (CA3 1983) (relying on "Congress' receptivity to new technology and its desire to encourage, through the copyright laws, continued imagination and creativity in computer programming"); *National Cable Tele*vision *Ass'n v. Copyright Royalty Tribunal*, 689 F.2d 1077, 1079 (CADC 1982) (explaining that it was this Court's holding that cable retransmission did not violate the copyrights of broadcasters under the 1909 Act that was a key impetus for enactment of the 1976 Copyright Act (*citing Teleprompter Corp. v. CBS*, 415 U.S. 394 (1974); *Fortnightly Corp. v. United Artists Television*, 392 U.S. 390 (1968))).

who print the paper copies of the Publications. In the terms of the Copyright Act, respondents' claims of direct copyright infringement must be gauged at the point the publications were "fixed" in the databases.[13]

The Second Circuit, however, did not follow that well-settled principle. Instead, it held, as a matter of law, that direct infringement liability may be imposed based solely on the ability of end users to cherry pick, out of the electronic copies, articles "individually or in combination with other pieces originally

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13. *MAI Sys. Corp. v. Peak Comp.*, 991 F.2d 511, 519 (CA9 1993) ("[I]t is generally accepted that the loading of software into a computer constitutes the creation of a copy under the Copyright Act," "whether the software is loaded into the RAM, the hard disk or the read only memory"); *see also Urantia Found. v. Maaherra*, 114 F.3d 955 (CA9 1997) (defendant engaged in copyright infringement by copying 2000 "revelations" published in plaintiff's book into searchable CD-ROM study guide); *Triad Sys. Corp. v. Southeastern Express Co.*, 64 F.3d 1330, 1333 & n.4 (CA9 1995) (holding that "copies * * * are made" when placed "in the computer's random access memory" or "onto the hard drive" or "onto tapes"); *Sega Enters. v. Accolade*, No. 92-15655 1993, U.S. App. LEXIS 78, at *18 (CA9 Jan. 6, 1993) ("In order to constitute a 'copy' for purposes of the Act, the allegedly infringing work must be fixed in some tangible form, 'from which the work can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device.' 17 U.S.C. § 101. The computer file generated by the disassembly program, the printouts of disassembled code, and the computer files containing Accolade's modifications that were generated during the reverse engineering process all satisfy that requirement."); *Atari Games Corp. v. Nintendo*, 975 F.2d 832, 842 (CA9 1992) (holding that copies were created at each stage in which computer code was "photocopie[d]," "hand-copied", and placed "into a computer"). Decisions of other circuits are to the same effect. *Stenograph LLC v. Bossard Assocs.*, 144 F.3d 96, 100 (CADC 1998) ("The language of the Copyright Act, case law, and common sense support the proposition that the installation of software into a computer results in 'copying' within the meaning of the Copyright Act."); *DSC Communications Corp. v. Pulse Communications*, 170 F.3d 1354 (CAFED 1999) ("copying" occurred when defendant transferred software from digital switching system to memory in computer card).

published in different editions of the periodical or in different periodicals." Pet. App. 6a. This unprecedented approach conflicts squarely with this Court's seminal holding in *Sony*, *supra*, that such end user, "[t]hird party conduct [is] wholly irrelevant in an action for direct infringement." *Sony*, 464 U.S. at 446. In *Sony*, motion picture studios claimed that manufacturers of video tape recorders were liable for copyright infringement because consumers could use the recorders to copy off-air television programming without permission. This Court refused to permit the court of appeals in that case to impose direct liability on the manufacturers for the acts of third-party consumers and held that, because the recorders were capable of "substantial noninfringing uses" (such as taping noncopyrighted programming or taping copyrighted programming for later non-commercial private viewing), contributory liability for infringement did not exist.

Other circuits have adhered faithfully to the distinction between direct and contributory infringement drawn by this Court in *Sony*. For example, in *Los Angeles News Serv. v. Tullo*, 973 F.2d 791 (CA9 1992), the Ninth Circuit held that the defendant (AVRS) infringed the plaintiff's (LAN) copyright in the contents of video tapes by recording the contents of the tapes from television programs and then distributing the material. The court explained that

> "LAN's claim against AVRS is not that AVRS is vicariously liable for alleged infringements by its customers but that it is directly liable for its own infringements: *The difference is crucial*; * * * * the ultimate use to which the customer puts the tape is irrelevant, as is the use AVRS's customers make of the tapes AVRS sells."

Id. at 797 (emphasis added). *See also MicroStar v. Formgen, Inc.*, 154 F.3d 1107, 1113 (CA9 1998) (refusing to consider third-party use of allegedly infringing work because claim asserted was for direct infringement); *Princeton Univ. Press v. Michigan Document Servs., Inc.*, 99 F.3d 1381, 1389

(CA6 1999) (en banc) (rejecting proposition that "copy shops" can assert fair use defense of end user in case of direct infringement: "It is true that the use to which the materials are put by the students who purchase the coursepacks is noncommercial in nature. But the use of the materials by the students is not the use that the publishers are challenging."); *RCA/Ariola Int'l v. Falcon Heights Pharm.*, 845 F.2d 773, 781 (CA8 1988) (recognizing that direct liability cannot turn "on what unknown customers may or may not do").[14]

The Second Circuit's decision simply cannot be reconciled with *Sony* and its progeny in the Sixth, Eighth and Ninth Circuits. The court of appeals concluded here that infringement existed *not* because the Publishers *reproduce or distribute* articles individually (it is beyond dispute that they do not), but instead because *users* of the CD-ROMs or the NEXIS database might *identify* and *read* those articles individually. That is precisely the third-party conduct that *Sony* holds irrelevant to a claim of direct copyright infringement.

Moreover, as the district court noted, respondents had expressly waived below all claims based on such third-party downloads. Pet. App. 33a n.3. This tactical choice is not surprising: Any such claim of contributory copyright infringement undoubtedly would fail because, as *Sony* also holds, the publishing activities challenged below need only be capable of "substantial noninfringing uses" to be protected under the Copyright Act's fair use provision, 17 U.S.C. § 107. 464 U.S. at 442. Given that the vast majority of retrievals by individuals, such as researchers, students, university professors, lawyers, and judges no doubt would qualify as a "fair use" under the Copyright Act, it is clear that the

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14. The Second Circuit's decision also specifically conflicts with the view of the United States Department of Justice as an *amicus* in *Matthew Bender & Co. v. West Publ'g Co.*, 158 F.3d 693 (CA2 1998), *cert. denied*, 119 S. Ct. 2039 (1999), which stressed the importance of a proper "direct" versus "contributory" infringement analysis.

substantial noninfringing uses defense — now precluded under the Second Circuit's unprecedented approach — otherwise would apply. *See generally Campbell v. Acuff-Rose Music*, 510 U.S. 569 (1994); *Harper & Row, Publishers v. Nation Enters.*, 471 U.S. 539 (1985). The Second Circuit, nonetheless, ran roughshod over this Court's holding in *Sony* — an error exemplified by its baffling failure even to *cite* this Court's *Sony* decision.[15]

B. The Decision Below Conflicts With Decisions Of This Court And Of Other Circuits Holding That "Originality" Is An Essential Element Of The Creation Of A "New" Work Under The Copyright Act.

The Second Circuit held in this case that the reproduction and distribution of electronic copies of periodical issues resulted in a new work outside the privilege accorded to publishers to create "any revision" of their periodicals. According to the Second Circuit, this new work was either "at best a new anthology of innumerable editions of * * * the [Publications], [or] at worst a new anthology of innumerable articles from these editions." Pet. App. 17a. It is undisputed, however, that the differences in the periodicals as fixed in print and as fixed in electronic copies are dictated by the different media involved, with the "revision" in this case characterized only by the omission of graphics, advertisements and agate-type entries. The Second Circuit's decision therefore conflicts with this Court's decision in *Feist*, holding that "[t]he sine qua non of copyright is originality" and that "mechanical" copying of a

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15. By implicitly assuming such end-user conduct to be infringing, the Second Circuit's decision also is in conflict with the decisions of the Fifth and Eleventh Circuits, both of which, in assessing contributory infringement claims, consider whether a product or service is capable of substantial non-infringing uses, such as fair uses. *Cable/Home Communications Corp. v. Network Productions, Inc.*, 902 F.2d 829, 846 (CA11 1990); *Vault Corp. v. Quaid Software, Ltd.*, 847 F.2d 255, 267 (CA5 1988).

work is not sufficient to create a new work, 499 U.S. at 345, and conflicts as well with the circuit court decisions following and elaborating upon *Feist*. Under those decisions, the act of transferring a work from one medium to another is deemed insufficiently original to result in a new work. The differences the Second Circuit identified as creating a "new" work — such features as coding, searchability and digitization — are the necessary and "inevitable" consequence of the very transfer to a new medium, *Feist*, 499 U.S. at 363, and are "dictated by functional considerations and common industry practice," *Bell South Adv. & Pub. Corp. v. Donnelly Info. Pub.*, 999 F.2d 1436, 1443 (CA11 1993). They cannot, therefore, give rise to a "new anthology" outside the scope of the "any revision" privilege. Put simply, a new work is not created by the mechanical way the databases are assembled. *See, e.g., Entertainment Research Group v. Genesis Creative Group*, 122 F.3d 1211, 1222 (CA9 1997) ("making decisions that enable one to reproduce or transform an already existing work into another medium" does not result in copyrightable work); *Superior Form Builders v. Dan Chase Taxidermy Supply Co.*, 74 F.3d 488, 493 (CA4 1996) ("mechanical process" of making casting from sculpture "allowed for no possibility of originality, which is inherent in authorship"); *Sherry Mfg. Co. v. Towel King*, 735 F.2d 1565, 1568 (CA11 1985) ("Thus, the one indispensable element of authorship is originality. One who slavishly or mechanically copies from others may not claim to be an author."); *Gracen v. Bradford Exchange*, 698 F.2d 300, 305 (CA7 1983) (oil painting of still frame from movie "differ[ed] only in the medium" and therefore was not copyrightable).

For this reason, the Copyright Office, empowered by Congress to administer the Act, 17 U.S.C. § 702, refuses to register automated databases "where the collection and arrangement" consists solely of "transferring data from hard copy to computer storage." Circular 65, Copyright Registration for Automated Databases 1 (U.S. Copyright Office 1999). The

Second Circuit's decision to the contrary impermissibly lowers the constitutional originality bar, and conflicts with the decisions of this Court and of other circuit courts of appeal, further pointing to the need for plenary review by this Court.

CONCLUSION

For the foregoing reasons, the petition for a writ of certiorari should be granted.

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